

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration of this application in view of the foregoing amendments to claims and the following comments.

In the Office Action mailed January 26, 2006, pending claims 1, 3-8, 10, and 12-15 were examined and rejected as follows:

- Claims 1, 6, and 10 were rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 3,861,434 to Harding (“Harding ‘434”);
- Claims 1 and 3-5 were rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 4,858,361 to White (“White ‘361”);
- Claims 1, 6, and 10 were rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 482,943 to Chang (“Chang ‘943”);
- Claims 1 and 3-5 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over U.S. Patent No. 3,145,749 to Rosenow (“Rosenow ‘749”) in view of U.S. Patent No. 3,161,932 to Russell (“Russell ‘932”);
- Claims 6, 7, 10, 12, and 13 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over Rosenow ‘749 in view of U.S. Patent No. 2,422,245 to Lauretti (“Lauretti ‘245”);
- Claim 8 was rejected under 35 U.S.C. § 103(a), as allegedly obvious over Rosenow ‘749 in view of U.S. Patent No. 2,705,039 to Halter (“Halter ‘039”) or U.S. Patent No. 4,784,248 to Workman (“Workman ‘248”);
- Claims 1, 3-7, 10, 12, and 13 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over Lauretti ‘245 in view of Russell ‘932;

- Claims 14 was rejected under 35 U.S.C. § 103(a), as allegedly obvious over Lauretti '245 in view of U.S. Patent No. 5,682,653 to Berglof et al. ("Berglof '653");

Additionally, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a), stating that the piping and the wire must be shown or the feature(s) canceled from the claims.

Applicants have canceled claim 8 without prejudice, rendering moot the rejections of claim 8. Applicants respectfully traverse the remaining rejections for the reasons set forth below.

Objection to the Drawings under 37 C.F.R. § 1.83(a)

As mentioned above, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a), stating that the piping and the wire must be shown or the feature(s) canceled from the claims.

By this Amendment, Applicants have canceled claim 8 without prejudice. Therefore, the Examiner's objection to the drawings under 37 C.F.R. 1.83(a) is moot and should be withdrawn.

Claims 2, 9, 11, and 20 under 37 C.F.R. § 1.142(b)

In light of the fact that claims 2, 9, 11, and 20 have been withdrawn under 37 C.F.R. § 1.142(b), Applicants respectfully request the Examiner to provide the particular reasons why the Examiner believes the fastening devices of each species is specific so that each type of fastening device must be searched separately. *See*, MPEP § 808.01(a) ("[T]here would be a serious burden on the examiner if restriction is not required. . . [W]here there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.")

§ 102(b) Rejection of Claims 1, 6, and 10 as Anticipated by Harding '434

In the Office Action, claims 1, 6, and 10 were rejected under 35 U.S.C. § 102(b), as allegedly anticipated by Harding '434.

Independent claim 1 recites a head cover for a golf club comprising a "cover body defining an inner compartment sized to fit a head of a golf club" and "a magnetic fastener positioned about the opening to at least partially shut the opening."

The Examiner stated that Harding '434 teaches a magnet fastener "positioned about the opening," as recited in claim 1. The Applicant respectfully disagrees with this assertion. Nowhere does Harding '434 teach or suggest that the plurality of magnets 29, 39 are positioned about the opening of tubular leg portion 5. As clearly shown in Figs. 3 and 5, the plurality of magnets 29, 39 are disposed well above the opening of tubular leg portion 5.

Moreover, because Harding '434 fails to teach or suggest that the plurality of magnets 29, 39 are positioned about the opening of tubular leg portion 5, the plurality of magnets could not possibly be adapted "to at least partially shut the opening," as recited in claim 1.

Accordingly, the 102(b) rejection of claim 1 over Harding '434 is improper and should be withdrawn. Claim 6 depends from claim 1 and, therefore, the rejection of claim 6 should be withdrawn for the same reason the rejection of claim 1 should be withdrawn.

Amended independent claim 10 recites a head cover for golf club comprising a cover body sized to fit a head of a golf club and "a magnetic fastener having first and second magnetic portions spaced apart from one another adjacent to the opening such that the first and second magnetic portions can engage one another to at least partially shut the opening."

Similar to the arguments set forth above with respect to claim 1, Applicants maintain that Harding '434 fails to disclose the invention recited in claim 10. Harding '434 fails to teach or suggest that the plurality of magnets 29, 39 are positioned adjacent to the opening of tubular leg portion 5. As clearly shown in Figs. 3 and 5, the plurality of magnets 29, 39 are disposed well above the opening of tubular leg portion 5. Moreover, because Harding '434 fails

to teach or suggest that the plurality of magnets 29, 39 are positioned adjacent to the opening of tubular leg portion 5, the plurality of magnets could not possibly be adapted "to at least partially shut the opening," as recited in claim 1.

Additionally Harding '434 fails to disclose a "magnetic fastener having first and second magnetic portions spaced apart from one another adjacent to the opening such that the first and second magnetic portions can engage one another to at least partially shut the opening," as recited in claim 10. Instead, Harding '434 discloses a head cover having *magnets*, which are "intended to be used with a golf club having a shaft which includes or carries a ferrous metal," wherein the magnets in the cover are attracted to the shaft and "magnetically attach the cover to the golf club." (Harding '434, col. 2, lines 27-35.)

Accordingly, the 102(b) rejection of claim 10 over Harding '434 is improper and should be withdrawn.

§ 102(b) Rejection of Claims 1 and 3-5 as Anticipated by White '361

In the Office Action, the Examiner rejected claims 1 and 3-5, as allegedly anticipated by White '361.

White '361 discloses a detachable cover for protecting the firing mechanism and/or telescopic sight of a rifle. The cover has a pliant, elongate body having first and second longitudinal edge portions adapted to be arranged in overlapping, substantially aligned relation to each other so that the body is of tubular configuration. Elongate magnets may be positioned on the longitudinal edge portions for releasably holding the edge portions in overlapping engagement to maintain the tubular configuration.

White '361 constitutes nonanalogous prior art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must be either in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MANUAL PATENT EXAMINING PROCEDURE § 2141.01(a); *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). A golf club is very different from a rifle.

The Examiner states that White '361 "teaches a cover defining an inner compartment, and a magnetic fastener about the opening" as claimed. Claim 1 recites "an inner compartment to accommodate a head of a golf club." Nowhere does White '361 teach an inner compartment to accommodate a head of a golf club.

Accordingly, the 102(b) rejection of claim 1 over White '361 is improper and should be withdrawn. Claims 3-5 depend from claim 1 and, thus, the rejections of claims 3-5 should be withdrawn for the same reason the rejection of claim 1 should be withdrawn.

§ 102(b) Rejection of Claims 1, 6, and 10 as Anticipated by Chang '943

In the Office Action, the Examiner rejected claims 1, 6, and 10, as allegedly anticipated by Chang '943.

Chang '943 discloses a case for protecting eyeglasses. The case has a pouch 10, a closure 14, and at least one magnetic fastener 16 to releasably attach the closure to the pouch.

Chang '943 constitutes nonanalogous prior art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must be either in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MANUAL PATENT EXAMINING PROCEDURE § 2141.01(a); *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). A golf club is very different from a eyeglass or contact lens case.

The Examiner states that Chang '943 "teaches a cover body with a magnetic fastener," as claimed. Claim 1 recites "an inner compartment to accommodate a head of a golf club." Nowhere does Chang '943 teach an inner compartment to accommodate a head of a golf club. Additionally, claim 1 recites "a magnetic fastener positioned about the opening." Nowhere does Chang '943 teach or suggest that the at least one magnetic fastener 16 is positioned about the opening of the pouch 10. As clearly shown in Figs. 1, 2, 6, 7, and 8, the at least one magnetic fastener 16 is disposed well away from the opening of the pouch 10.

Accordingly, the 102(b) rejection of claim 1 over Chang '943 is improper and should be withdrawn. Claim 6 depends from claim 1 and, thus, the rejections of claim 6 should be withdrawn for the same reason the rejection of claim 1 should be withdrawn.

Claim 10 recites "an inner compartment to accommodate a head of a golf club." Nowhere does Chang '943 teach an inner compartment to accommodate a head of a golf club. Additionally, claim 1 recites a magnetic fastener "adjacent to the opening." Nowhere does Chang '943 teach or suggest that the at least one magnetic fastener 16 is positioned adjacent to the opening of the pouch 10. As clearly shown in Figs. 1, 2, 6, and 7, the at least one magnetic fastener 16 is disposed well away from the opening of the pouch 10.

Accordingly, the 102(b) rejection of claim 10 over Chang '943 is improper and should be withdrawn.

§ 103(a) Rejection of claims 1 and 3-5 as compared to Rosenow '749 and Russell '932

In the Office Action, the Examiner rejected claims 1 and 3-5 under 35 U.S.C. § 103(a), as allegedly obvious over Rosenow '749 in view of Russell '932.

Rosenow '749 discloses a golf club head cover having a placket 15 extending the length of the headcover and a conventional "Zipper" type closure device 17 to close the placket. Russell '932 discloses a magnetic strip fastener for apparel, more specifically for baby garments and other fragile fabrics. (Russell '932, col. 1, lines 8-10.)

On page 3 of the Office Action, the Examiner stated that Rosenow '749 teaches a head cover having a zipper fastener. The Examiner further stated that it would have been obvious to substitute the magnetic fastener in Russell '932 for the zipper fastener in Rosenow '749. Applicants maintain that the Examiner's reliance on Russell '932 to remedy the deficiencies of Rosenow '749 is misplaced. Russell '932 is directed to "closures and closure fasteners for garments, particularly for baby garments and other fragile fabrics." (Russell '932, col. 1, lines 7-10.)

“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must be either in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” MANUAL PATENT EXAMINING PROCEDURE § 2141.01(a); *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). In *Oetiker*, the Federal Circuit held that the reference was not within the field of the applicant’s endeavor and not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill seeking to solve the problem, would reasonably be expected or motivated to look to the non-analogous field to solve the problem. *Id.*

Similar to *Oetiker*, a person of ordinary skill in designing head covers for golf clubs would not reasonably be expected or motivated to look to fasteners used with fragile fabrics like baby clothes to solve the problems associates with head covers. The teachings of Russell ‘932 bear no relation to the field of golf, and clearly have no relation to golf club head covers. There is no motivation to combine the teachings of Russell ‘932 with Rosenow ‘749.

Accordingly, Russell ‘932 is nonanalogous prior art that should not be relied upon in support of an obviousness rejection under Section 103. Therefore, it would not have been obvious to replace the zipper in Rosenow ‘749 with the magnetic closure disclosed in Russell ‘932. Because the Examiner failed to cite to a combination of analogous prior art references that disclose all of the limitations of independent claim 1, the obviousness rejections are improper and should be withdrawn. MANUAL PATENT EXAMINING PROCEDURE § 2143.03; *see also In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”).

Claims 3-5 depend from claim 1 and, thus, the rejections of claims 3-5 should be withdrawn for the same reason the rejection of claim 1 should be withdrawn.

§ 103(a) Rejection of claims 6, 7, 10, 12, and 13 as compared to Rosenow '749, Russell '932, and Lauretti '245

In the Office Action, claims 6, 7, 10, 12, and 13 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over Rosenow '749, Russell '932, and Lauretti '245.

Claims 6 and 7 depend from independent claim 1. Similar to the arguments made in the prior section, the invention recited in claim 1 is not obvious over Rosenow '749, in view of Russell '932. A person of ordinary skill in designing head covers for golf clubs would not reasonably be expected or motivated to look to fasteners used with fragile fabrics like baby clothes to solve the problems associated with head covers. The teachings of Russell '932 bear no relation to the field of golf, and clearly have no relation to golf club head covers. There is no motivation to combine the teachings of Russell '932 with Rosenow '749.

Claims 6 and 7 depend from claim 1 and, thus, the rejections of claims 6 and 7 is improper and should be withdrawn.

On page 3 of the Office Action, the Examiner stated that Rosenow '749 teaches a head cover having a zipper fastener. The Examiner further stated that it would have been obvious to substitute the magnetic fastener in Russell '932 for the zipper fastener in Rosenow '749. The Examiner further stated that it would also have been obvious to provide a liner, as taught by Lauretti '245, for added protection.

Applicants maintain that the Examiner's reliance on Russell '932 to remedy the deficiencies of Rosenow '749 is misplaced. Russell '932 is directed to "closures and closure fasteners for garments, particularly for baby garments and other fragile fabrics." (Russell '932, col. 1, lines 7-10.) "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must be either in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MANUAL PATENT EXAMINING PROCEDURE § 2141.01(a); *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). In *Oetiker*, the Federal Circuit held that the reference was not within the field of the applicant's endeavor and not reasonably pertinent to the particular problem with which the

inventor was concerned because it had not been shown that a person of ordinary skill seeking to solve the problem, would reasonably be expected or motivated to look to the non-analogous field to solve the problem. *Id.*

Similar to *Oetiker*, a person of ordinary skill in designing head covers for golf clubs would not reasonably be expected or motivated to look to fasteners used with fragile fabrics like baby clothes to solve the problems associates with head covers. The teachings of Russell '932 bear no relation to the field of golf, and clearly have no relation to golf club head covers. There is no motivation to combine the teachings of Russell '932 with Rosenow '749.

Accordingly, Russell '932 is nonanalogous prior art that should not be relied upon in support of an obviousness rejection under Section 103. Additionally, Lauretti '245 fails to remedy the deficiencies of Rosenow '749. Therefore, it would not have been obvious to replace the zipper in Lauretti '245 or Rosenow '749 with the magnetic closure disclosed in Russell '932.

Because the Examiner failed to cite to a combination of analogous prior art references that disclose all of the limitations of independent claim 10, the obviousness rejections are improper and should be withdrawn. MANUAL PATENT EXAMINING PROCEDURE § 2143.03; *see also In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ("To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."). Therefore the rejection of claim 10 under Section 103 is improper and should be withdrawn.

§ 103(a) Rejection of Claim 8 as Compared to Rosenow '749, Halter '039, and Workman '248

By this Amendment, Applicants have canceled dependent claim 8 without prejudice. Therefore, the Examiner's rejection of claim 8 is moot.

§ 103(a) Rejection of 1, 3-7, 10, 12, and 13 as Compared to Lauretti '245 and Russell '932

In the Office Action, the Examiner rejected claims 1, 3-7, 10, 12, and 13 under 35 U.S.C. § 103(a), as allegedly anticipated by Lauretti '245 in view of Russell '932.

The Examiner stated that Lauretti '245 teaches a head cover with fastener being a zipper 15. The Examiner further stated that it would have been obvious for one of ordinary skill in the art to provide the magnetic fastener in Rosenow '749 as taught by Russell '932 to provide an alternative fastener.

Applicants maintain that the Examiner's reliance on Russell '932 to remedy the deficiencies of Rosenow '749 or Lauretti '245 is misplaced. Russell '932 is directed to "closures and closure fasteners for garments, particularly for baby garments and other fragile fabrics." (Russell '932, col. 1, lines 7-10.) "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must be either in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MANUAL PATENT EXAMINING PROCEDURE § 2141.01(a); *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). In *Oetiker*, the Federal Circuit held that the reference was not within the field of the applicant's endeavor and not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill seeking to solve the problem, would reasonably be expected or motivated to look to the non-analogous field to solve the problem. *Id.*

Similar to *Oetiker*, a person of ordinary skill in designing head covers for golf clubs would not reasonably be expected or motivated to look to fasteners used with fragile fabrics like baby clothes to solve the problems associates with head covers. The teachings of Russell '932 bear no relation to the field of golf, and clearly have no relation to golf club head covers. There is no motivation to combine the teachings of Russell '932 with Lauretti '245 or Rosenow '749.

Accordingly, Russell '932 is nonanalogous prior art that should not be relied upon in support of an obviousness rejection under Section 103. Additionally, Lauretti '245 fails to remedy the deficiencies of Russell '932 and Lauretti '245. Therefore, it would not have been obvious to replace the zipper in Lauretti '245 with the magnetic closure disclosed in Russell '932. Because the Examiner failed to cite to a combination of analogous prior art references that disclose all of the limitations of independent claims 1 and 10, the obviousness rejections are

improper and should be withdrawn. MANUAL PATENT EXAMINING PROCEDURE § 2143.03; *see also In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”).

Accordingly, the rejection of independent claims 1 and 10 under Section 103 is improper and should be withdrawn. Claims 3-7, and claims 12 and 13, depend from claims 1 and 10, respectively, and should be allowable for the same reasons claims 1 and 10 are allowable.

Secondary Considerations of Non-Obviousness

Additionally, there are several secondary considerations that support a finding that the inventions recited in claims 1, 3-7, 10, 12, and 13 are non-obvious, namely evidence of long felt but unsolved needs and copying by others.

The inventions recited in claims 1, 3-7, 10, 12, and 13 represents a long felt but unsolved need in the field of golf club head covers. There are two general categories of head covers for golf club drivers. In the first category of driver head covers, the head cover looks like a sock, and is installed by pulling the head cover over the club head. Placing the head cover on the club head generally requires two hands. It can be difficult to install a sock-type head covers on a late model driver with a large volume club head.¹ Consequently, many golfers who use high volume club heads do not install their sock-type head covers onto their drivers after teeing off, and the driver club head and shaft can be damaged in the golf bag due to contact with other clubs in the bag as a golfer transports his clubs around a golf course. The driver is generally the most expensive club in a set of clubs, so repairing or replacing a damaged driver is generally costly. (Crocker Decl., ¶ 3.)

¹ Under the United States Golf Association (www.usga.org) Rule 4(b)(i), a wood type club head cannot exceed a volume of 460 cubic-centimeters. A copy of Rule 4 is attached as Exhibit B. Until recently, most drivers were under the USGA 460 cubic-centimeter club head volume limitation. In other words, most older model drivers had smaller club heads than most current driver models. Nowadays, most drivers are at or very close to the USGA 460 cubic-centimeter club head volume limitation. (Crocker Decl., ¶ 2.)

In the second category of driver head covers, the head cover has a slit up the side with a traditional mechanical zipper. The head cover is installed by opening the zipper, pulling the head cover over the club head, and then closing the zipper. This is multi-step process that generally requires two hands. (Crocker Decl., ¶ 4.)

A driver head cover with a magnetic closure can generally be more easily installed in less time than a head cover with a mechanical zipper. This is especially true for older or physically handicapped golfers who suffer from arthritis or other debilitating medical problems that limit finger dexterity and coordination. Consequently, a driver headcover with a magnetic closure will be used more often than other traditional types of headcovers, and a golfer is less likely to damage an expensive driver while transporting his clubs around a golf course. (Crocker Decl., ¶ 5.)

Thus, until the invention of the head cover recited in claims 1, 3-7, 10, 12, and 13, there had been a long felt but unsolved need for a head cover that can be installed quickly and easily, and which does not involve a multi-step process. Such evidence supports a finding of non-obviousness. *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 1361 (Fed. Cir. 1999) (a “jury reasonably could have found there was a long-felt but unmet need in the prior art for an improved balancing method, which the Swin patents satisfied.”).

Additionally, there is evidence that others have copied one or more golf club head covers sold and distributed by Taylor Made that embody the claimed invention. Tartan Sports currently sells a driver head cover—the Magcover (Model. No. TS-291)—that features a magnetic fastener/ closure. Tartan Sports began selling this head cover after Taylor Made starting selling its “Tour Preferred” driver head cover. The Magcover head cover embodies the invention(s) recited in claims 1, 3-7, 10, 12, and 13. (Crocker Declaration, ¶ 6, Exh. A.) Tartan Sport’s Magcover head cover embodies the invention recited in claims 1, 3-7, 10, 12, and/or 13. (*Id.*) For example, the head cover comprises: (1) a cover body formed essentially of flexible, non-rigid material, the cover body defining an inner compartment sized to fit a head of a golf club and defining an opening of sufficient size for the head of the golf club to be inserted into

and removed from the inner compartment; and (2) a magnetic fastener positioned about the opening to at least partially shut the opening.

The above-identified patent application is assigned to Taylor Made Golf Company ("Taylor Made"). (See Reel/Frame No. 014704/0226.) Tartan Sport's Magcover is very similar to Taylor Made's "Tour Preferred" driver head cover. Taylor Made's "Tour Preferred" head cover embodies the invention recited in claims 1, 3-7, 10, 12, and/or 13 of the above-identified patent application. (Crocker Declaration, ¶ 7.) The fact that Adams Golf has copied Taylor Made's "Tour Preferred" head cover is further evidence of non-obviousness. *Avia Group International, Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1564 (Fed. Cir. 1988) ("Copying is additional evidence of nonobviousness.")

Accordingly, the evidence of a long felt but unsolved need and copying by others supports the conclusion that the inventions recited in claims 1, 3-7, 10, 12, and 13 are not obvious.

New Claim 16

By this Amendment, Applicants have added new dependent claim 16. Claim 16 depends from claim 1, and should be allowable for the same reasons claim 1 is allowable

Appl. No. 10/622,006
Response dated July 26, 2006
Reply to Office Action mailed January 26, 2006

CONCLUSION

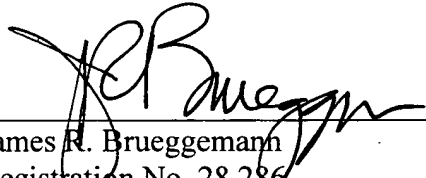
This application should be in condition for favorable examination. Early issuance of a notice of allowance is respectfully requested. If the Examiner believes that this might be expedited by a telephone conference with Applicants' representative, the Examiner is respectfully requested to call the undersigned attorney at the number indicated below. If any additional fees are due in connection with this filing, please charge the fees to our Deposit Account No. 19-1853.

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Respectfully submitted,

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